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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,646	01/23/2001	Youji Kohda	1405.1032/JDH	4296
21171	7590	03/26/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,646

Applicant(s)

KOHDA ET AL.

Examiner

John L Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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2. Claims 1-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nguyen 5,931,917 (8/3/99) [f/d: 9/26/96] (herein referred to as "Nguyen").

As per claim 1, Nguyen (the ABSTRACT; col. 80, ll. 61-67; col. 81, ll. 1-20; col. 56, ll. 1-30; FIG. 18A; FIG. 25; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 2; FIG. 3; FIG. 4; FIG. 9; FIG. 10; FIG. 14; FIG. 15A; FIG. 15B; FIG. 17; FIG. 18B; FIG. 19; FIG. 20A; FIG. 20B; FIG. 20C; FIG. 21A; FIG. 22; FIG. 23; FIG. 24; FIG. 26; FIG. 27; FIG. 28; FIG. 29/ FIG. 30; FIG. 31; FIG. 32; FIG. 33; FIG. 34; FIG. 35; FIG. 37; FIG. 38; FIG. 39; FIG. 40; FIG. 42; FIG. 43; FIG. 44; FIG. 45; FIG. 46; FIG. 47; FIG. 48; FIG. 50; FIG. 62; FIG. 63; FIG. 64; FIG. 65; FIG. 67; FIG. 68; FIG. 69; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and whole document) shows the elements and limitations of claim 1.

Nguyen shows "*combines . . . authorization request . . . its . . . certificate . . . and its signature public key certificate. . .*" (See Nguyen col. 16, ll. 37-52).

Nguyen shows a method for initializing a series of electronic transactions. (See Nguyen col. 88, ll. 16-20).

Nguyen shows elements that suggest binding authorization data. (See Nguyen col. 88, ll. 21-26; and col. 88, ll. 9-12).

Nguyen does not explicitly recite the elements and limitations of claim 1 even though Nguyen reasonably suggests same. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Nguyen (col. 80, ll. 61-

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67; col. 81, ll. 1-20; col. 56, ll. 1-30; FIG. 18A; FIG. 25; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 2; FIG. 3; FIG. 4; FIG. 9; FIG. 10; FIG. 14; FIG. 15A; FIG. 15B; FIG. 17; FIG. 18B; FIG. 19; FIG. 20A; FIG. 20B; FIG. 20C; FIG. 21A; FIG. 22; FIG. 23; FIG. 24; FIG. 26; FIG. 27; FIG. 28; FIG. 29/ FIG. 30; FIG. 31; FIG. 32; FIG. 33; FIG. 34; FIG. 35; FIG. 37; FIG. 38; FIG. 39; FIG. 40; FIG. 42; FIG. 43; FIG. 44; FIG. 45; FIG. 46; FIG. 47; FIG. 48; FIG. 50; FIG. 62; FIG. 63; FIG. 64; FIG. 65; FIG. 67; FIG. 68; FIG. 69; col. 1, ll. 10-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; and whole document) would have been selected in accordance with showing “an on-line incentive offering program . . . an incentive module, programmed to automatically activate incentive offers in response to data received from said shopping cart module. . . .” because such selection would have provided means where “*control passes . . . to the WWW server . . . for the transaction to be appropriately formatted and the appropriate interface page presented, whether the transaction is a store front . . . shopping cart . . . pay page . . . standard terminal administration . . . transaction, or an extended terminal transaction. . . .*” (See Nguyen (col. 56, ll. 10-28)).

As per dependent claims 2-10, Nguyen shows the method of claim 1 and subsequent base claims depending from claim 1.

Nguyen does not explicitly recite the elements and limitations of claims 2-10 even though Nguyen reasonably suggests same.

Official Notice is taken that both the concepts and the advantages of the elements

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and limitations of claims 2-10 were notoriously well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-10, because selection of such features would have provided means where *“control passes . . . to the WWW server . . . for the transaction to be appropriately formatted and the appropriate interface page presented, whether the transaction is a store front . . . shopping cart . . . pay page . . . standard terminal administration . . . transaction, or an extended terminal transaction. . . .”* (See Nguyen (col. 56, ll. 10-28)).

Independent claim 11 is rejected for substantially the same reasons as independent claim 1.

Independent claim 12 is rejected for substantially the same reasons as independent claim 1.

Independent claim 13 is rejected for substantially the same reasons as independent claim 1.

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### CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

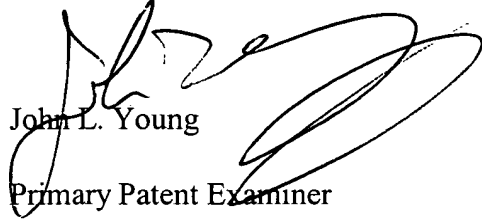
Serial Number: 09/766,646

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young  
Primary Patent Examiner

February 18, 2004